

Application Serial No. 10/721,301
Amendment dated March 10, 2005
Reply to Office Action of September 10, 2004

Atty Dkt No. 2750-0001.10

Remarks

Overview

In the Office Action under reply, the following objections to, and rejections of, the claims have been set forth:

Claim 1 has been objected to due to certain informalities;

Claims 1-26 have been rejected as being indefinite due to the use of the term "substituted";

Claims 1,2,14-16, and 24 have been rejected as being indefinite due to the use of the term "analogs thereof"; and,

Claim 1 has been rejected due to confusing definitions recited for the substituent D.

Applicant respectfully submits that the foregoing objections and/or rejections are obviated due to the amendments to the claims, or, for the reasons detailed below, traverses the rejections.

Amendments to the claims

By the foregoing amendments, claim 1 has been amended to recite that "D is O, S or N11" as suggested by the Examiner. Support for this amendment may be found in the specification at least at page 10 in paragraph [00023].

Claims 1, 2, 14-16, and 24 have also been amended to recite that "B is a nucleobase" by deleting the recitation that the nucleobase is "selected from the group consisting of unprotected and protected purines, pyrimidines, and analogs thereof." Support for this amendment may be found at least at page 10 in paragraph [00023].

Claims 1 and 15 have further been amended to include appropriate commas between the recited members for the moiety X.

No new matter has been entered by these amendments.

Objection to the claims

Claim 1 has been objected to due to the omission of certain commas in the list of members recited for the moiety X.

By the foregoing amendment, claim 1 has been corrected to include suitable commas to separate the recited members. Accordingly, applicant submits that this objection has been obviated. Withdrawal of the objection is requested.

Applicant further notes that a similar amendment has been entered for claim 15 for reasons of maintaining consistency in the claim language.

Applicant respectfully submits that the foregoing amendment does not have any bearing on the patentability of the claimed subject matter and does not affect the scope of the claims.

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Rejections under 35 U.S.C. §112, second paragraph

Claims 1-26 have been rejected as being indefinite due to the use of the term "substituted."

Applicant respectfully traverses this rejection for at least the following reasons.

At the outset, it is noted that the language of the claims is to be read in light of applicant's disclosure. A claim is not indefinite if one of ordinary skill in the art would reasonably understand the meaning of the claim or term based on applicant's disclosure. "The requirement that the claims 'particularly point out and distinctly claim' the invention is met when a person experienced in the field of the invention would understand the scope of the subject matter that is patented when the claim is read in conjunction with the rest of the specification. 'If the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.'" Miles Laboratories, Inc. v. Shandon, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993); see also Union Pacific Resources Co. v. Chesapeake Energy Corp., 236 F.3d 684, 692, 57 USPQ2d 1293, 1297 (Fed. Cir. 2001); North American Vaccine, Inc. v. American Cyanamid Co., F.3d 1571, 1579, 28 USPQ2d 1333, 1339 (Fed. Cir. 1993); Hybritech, Inc. v. Monoclonal Antibodies, 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986)."

In the present case, the term "substituted" is more than adequately described in applicant's specification, e.g., at page 14 in paragraph [00040] in reference to substituted alkylenes, and in paragraph [00039] for substituted alkyl groups; at pages 14-15 in paragraph [00041] for substituted alkenyl; at page 15 in paragraph [00042] for substituted alkynyl, and in paragraph [00044] for substituted amino; at pages 15-16 in paragraph [00045] for substituted aryl; and, at page 15 in paragraph [00046] for substituted arylene. Other substituents are referred to in paragraphs [00047] and [00049]. In addition, the term "substituted" is described at pages 18-19 in paragraph [00053]. Given this substantial discussion and definition of the term "substituted," the skilled artisan would readily understand what is meant by this terminology as well as the scope of applicant's claims.

Applicant also notes that the term "substituted" has been used in many U.S. patent claims without further recitation of the specific substituents in the claim. Typically, the use of this term in the claims may be appropriate where, as here, comprehensive supporting discussion and definitions in the specification support such a use. Representative U.S. patents in which the term "substituted" has been allowed in the claims include U.S. Pat. Nos. 6,803,429, 6,723,828, and 6,248,305, to name a few. While it is true that each case is evaluated on its' own merits, the prior approval of the use of this term in the claims suggests that the present application should be evaluated in a similar way.

With regard to the use of the term "analogs thereof," applicant notes that this term has been deleted from the claims. As such, this aspect of the second paragraph rejection is no longer applicable.

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In addition, claim 1 has been amended to correct the definitions recited for the substituent D, such that the prior rejection on this basis has also been obviated.

For at least the foregoing reasons, applicant requests withdrawal of the second paragraph rejections.

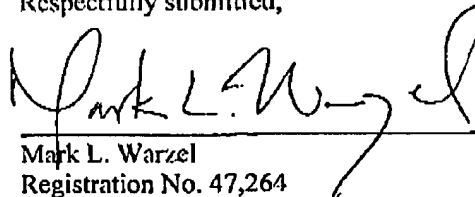
Conclusion

The above arguments and amendments are submitted in an effort to place this application in condition for allowance and for the purpose of facilitating allowance of the claims. An early notice of allowance is earnestly requested.

If in the opinion of the Examiner, a telephone conference would clarify any remaining matters, or expedite the prosecution of the subject application, a telephone call to the undersigned at (650) 330-0900 would be appreciated.

Respectfully submitted,

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